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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,833	01/08/2002	Masanobu Okada	P/1071-1543	7681

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Keating & Bennett
10400 Eaton Place
Ste. 312
Fairfax, VA 22030

EXAMINER

TRINH, MINH N

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,833

Applicant(s)

OKADA, MASANOBU *cn*

Examiner

Minh Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/627,021.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/11/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 6, 10 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lonka (US 5,365,410). This rejection is set forth in prior Office Action, paragraph 5, dated 11/05/03.
3. Claims 6-7, 9-11 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lonka. This rejection is set forth in prior Office Action, paragraph 7, dated 11/05/03.
4. Claims 8, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lonka in view of Applicant Admitted Prior Art (APA) see Applicant's Specification pages 2-3. This rejection is set forth in prior Office Action, paragraph 8, dated 11/05/03.

Response to Arguments

5. Applicant's arguments filed in 3/11/2004 have been fully considered but they are not persuasive. For the following reasons:

a) Applicant's arguments (see page 8, paragraph 2) that Lonka does not teach the feature of the plurality of leg sections as presented in the present claims (see claims 6, 10 and 16). The Examiner disagrees, Applicant is referred to Fig. 1 of Lonka which indeed shows a plurality of leg sections or side wall (15) having necks 7, 11 and cut off sections 8, 12, 13, 14 associated therefrom. Noted that necks 7 and 11 are truly part of 15 and is interpretation the "leg sections" as broadly claimed by the present invention. Therefore, the recitation "the plurality leg sections" is satisfied by Lonka reference. It is noted that Applicant's arguments are more specific than the claim language. Applicant also lends great means to the feature "leg section" and it appears that the feature 15 including necks 7 and 11 satisfies the examiners interpretation of the leg sections as claimed by Applicant. Furthermore, it is noted that the "plurality of leg sections" is not positive method limitation because it is recited in the preamble of the claim. In response to applicant's arguments, the recitation "the plurality of leg sections" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hiraio*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

b) Applicant's arguments (see page 9, paragraphs 1-2) that Lonka does not teach the "inserting a cutting tool into a corresponding said tool insertion opening and cutting the corresponding leg section away from the cover with said cutting tool". The

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Examiner disagrees, Applicant is referred to Lonka's discussion at col. 2, lines 40-45 indeed teach the method feature as described above. It is noted that Applicant should be aware that the claim languages are interpreted in light of the specification, limitations from the specification are not to be read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In light of the above, Applicant's arguments with respect to Lonka alone or in view of APA set forth in prior rejections are moot.

Interviews After Final

6. Applicant notes that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing). Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search will be denied. See MPEP 714.13 and 713.09.

Conclusion

7. Please provide numeral references to the claimed limitations as well as support in the disclosure (i.e., page and line numbers and reference number associated with from the drawings) for better clarity. Applicant requires to point out the support for any

amendment made to the disclosure and the claims. See 37CFR 1.111 and section 2163.06 of the MPEP.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Minh Trinh 5/25/04
Examiner Group 3700

mt
5/25/04